

**REMARKS**

The disclosure was objected to because of informalities. Claim 25 was rejected under 35 U.S.C. 101 because the disclosed invention was inoperative and therefore lacks utility. Claims 20, 21, 27, 31 and 33 to 37 were rejected under 35 U.S.C. 102(b) as being anticipated by Updegrove et al (US 6,165,345). Claims 40 and 43 were rejected under 35 U.S.C. 102(b) as being anticipated by Goto et al. (U.S. Pat. Publication 2006/0086617 A1). Claims 22 to 26, 28 to 29, and 32 were rejected under 35 U.S.C. 103(a) as being unpatentable over Updegrove et al., in view of Tchugunov (US 6,835,299). Claim 30 was rejected under 35 U.S.C. 103(a) as being unpatentable over Updegrove et al., in view of Tchugunov as applied to claim 28, above, and further in view of Jaworowski et al. (US 6,176,999 B1). Claims 38 to 39 were rejected under 35 U.S.C. 103(a) as being unpatentable over Updegrove et al., in view of Kariya et al. (US 6,531,049 B1). Claim 42 was rejected under 35 U.S.C. 103(a) as being unpatentable over Goto et al. in view of Ogawa et al. (US 6,596,200 B1). Claim 42 was rejected under 35 U.S.C. 103(a) as being unpatentable over Goto et al. in view of Updegrove et al.

Claims 20, 25, 32 and 44 have been amended. Support is found in original claim 28 and at [0022] for example. Claim 28 has been canceled without prejudice.

Reconsideration of the application as amended is respectfully requested.

**Objection to the Specification:**

The disclosure was objected to because of informalities in paragraphs [0009] and [0010].

Applicants respectfully point out that the objected paragraphs [0009] and [0010] were cancelled in the Preliminary Amendment filed together with the Application on August 28, 2006.

Applicants respectfully request that the Amendments be entered and the objections to the specification be withdrawn.

**Rejections under 35 U.S.C § 101:**

Claim 25 was rejected under 35 U.S.C. 101 because the disclosed invention was inoperative and therefore lacks utility.

Claim 25 has been amended, without prejudice, as suggested by the Examiner.

Withdrawal of the rejection under 35 U.S.C. 101 to claim 25 is respectfully requested.

**Rejections under 35 U.S.C § 102(b):**

Claims 20, 21, 27, 31 and 33 to 37 [SIC: and 44] were rejected under 35 U.S.C. 102(b) as being anticipated by Updegrove et al.

Claims 20 and 44 has been amended to recite the limitation of previous claim 28.

Withdrawal of the rejection under 35 U.S.C. 102(b) to claims 20, 21, 27, 31 and 33 to 37 is respectfully requested.

Claims 40 and 43 were rejected under 35 U.S.C. 102(b) as being anticipated by Goto et al.

Goto forms an electrode based on mold dies and lower and upper punches. See Fig. 1 or Fig. 6 and disclosure at [0073] and [0074] for example. Co powder for example is compression molded to a shape using the mold dies. The formed electrode 41 is then used to coat a workpiece 42, as shown in Fig. 9 and disclosed at [0081] for example.

Claim 40 recites an electrode for electrochemically stripping components comprising:  
an impression of a component region to be stripped, the impression being formed from a moldable, electrically conductive compound.

Electrode 41 of Goto is not “an impression of a component region to be stripped” as recited in claim 40. It is an impression of the mold dies, which are not any component region to be stripped or processed at all. The mold dies are never processed in any way in Goto and withdrawal of the rejection is respectfully requested. Also, nothing in Goto is to be stripped, since the electrode in Goto is for forming surface coats.

Withdrawal of the rejection under 35 U.S.C. 102(b) to claims 40 and 43 is respectfully requested.

**Rejections under 35 U.S.C § 103(a):**

Claims 22 to 26, 28 to 29, and 32 were rejected under 35 U.S.C. 103(a) as being unpatentable over Updegrove et al., in view of Tchugunov.

Updegrove is discussed in detail at [0004] of the present application.

Tchugunov discloses an electrochemical machining method and apparatus for machining metal workpieces. See col 1, lines 9 to 24. High currents are desirable to attain high rates of

removal of material. See col. 1 lines 21 to 23.

With respect to previous claim 28, claim 20 now recites “electrochemically stripping the component by time pulsing a current or voltage applied by the voltage or current source.”

As noted in the present specification at [0004], Updegrove operates at a constant voltage and current for a very short period of time, on the order of 10 minutes or less. See col. 2, lines 2 to 10. Updegrove states that it has a very short overall cycle time and provide uniform coating removal. See col. 2, lines 18 to 27.

Thus Updegrove clearly does not need or require increased “erosion efficiency” or “to minimize stray erosion” which is the proposed motivation in the present Office Action at page 9, paragraph 32. Due to the grid of Updegrove, there appears to be no stray erosion or requirement for increased erosion efficiency, as with the machining device of Tschugunov.

In fact, Tchugunov also is not concerned with coating removal, but rather in actual machining of a workpiece using a rotating cathode. There simply is no evidence or factual basis to suspect that the problems found with the Tchugunov machining cathode are found in the stationary grid of the Updegrove.

It is respectfully submitted that it would not have been obvious to one of skill in the art, in view of Tchugunov, to have modified Updegrove, since there simply was no need or reason to do so in view of the teachings of Tchugunov.

Withdrawal of the rejection under 35 U.S.C. 103(a) to claims 22 to 26, 28 to 29, and 32 is respectfully requested.

It is further noted with respect to claim 32, which has been amended, that Updegrove does not use a change in potential as any criterion as now claimed. See present specification at [0022].

Claim 30 was rejected under 35 U.S.C. 103(a) as being unpatentable over Updegrove et al., in view of Tchugunov as applied to claim 28, above, and further in view of Jaworowski et al.

In view of the above, withdrawal of the rejection under 35 U.S.C. 103(a) to claims 22 to 26, 28 to 29, and 32 is respectfully requested.

Claims 38 to 39 were rejected under 35 U.S.C. 103(a) as being unpatentable over Updegrove et al., in view of Kariya et al. in view of the above, withdrawal of the rejection under 35 U.S.C. 103(a) to claims 38 to 39 is respectfully requested.

Claim 42 was rejected under 35 U.S.C. 103(a) as being unpatentable over Goto et al. in

view of Ogawa et al. in view of the above, withdrawal of the rejection under 35 U.S.C. 103(a) to claim 42 is respectfully requested.

Claim 42 was rejected under 35 U.S.C. 103(a) as being unpatentable over Goto et al. in view of Updegrove et al. In view of the above, withdrawal of the rejection under 35 U.S.C. 103(a) to claim 42 is respectfully requested.

### **CONCLUSION**

Reconsideration and allowance of the present application is therefore respectfully requested. Applicant believes that no fees are due as a result of this amendment. In the event of a fee discrepancy, please charge our Deposit Account No. 50-0552.

Respectfully submitted,

DAVIDSON, DAVIDSON & KAPPEL, LLC

By:   
William C. Gehris, Reg. No. 38,156

Davidson, Davidson & Kappel, LLC  
485 Seventh Avenue - 14<sup>th</sup> Floor  
New York, New York 10018  
(212) 736-1940